

REMARKS

In the Office Action, the Examiner objected to claims 29-31. Each of the Examiner's objections is discussed below, along with an appropriate remedy.

5 Rejection Under 35 USC §102 – Anticipation

The Examiner states that Claims 29 to 31 are anticipated by Bennett (US 6,585,264). Applicant respectfully submits that Bennett does not teach the same invention as the present application and provides no grounds for rejection, as discussed in the four (4) sections below:

10 1. Bennett teaches a game using the predefined movement patterns of board game pieces, such as chess with king, queen, bishop, rook, knight, and pawn pieces.

Bennett's specification describes a game with "at least one representation of a playing piece of a predetermined board game, where each type of such playing piece has a predefined movement pattern in said board game, is displayed, the, or each, representation of the playing piece having its predefined movement pattern as it applies to the board game..." (Bennett at
15 column 1, lines 38 to 44; emphasis added.)

Further, Bennett's only independent claim states in relevant part that "at least one representation of a playing piece of a predetermined board game, where each type of such playing piece has a predefined movement pattern in said board game, is displayed, the at least
20 one representation of the playing piece moves in a pattern corresponding the predefined pattern of that playing piece as it applies in the board game..." (Bennett, column 4, line 65; to column 5, line 4; emphasis added.)

Bennett, therefore, relies upon the existence of a board game with pieces to provide movement patterns upon which to base the movement of the representation of said playing pieces in the game taught by Bennett.

The present invention, however, teaches methods by which wildcard symbols expand in one or more predetermined directions without any regard to a board game or the movement patterns of pieces defined by said board game. Specifically, the application describes "...wild symbols that expand in a pre-determined vertical direction – upwards or downwards. The upwards wild symbol ("Up Wild") converts all of the symbol positions above the Up Wild into wild symbols. The downwards wild symbol ("Down Wild") converts all of the symbol positions below the Down Wild into wild symbols... (Directional Wild application, page 9, paragraph 2.)

2. Bennett teaches a game requiring a control means to determine one of the plurality of directions in which to execute the predefined movement pattern of a playing piece.

Bennett's specification states that "[w]here the chess piece can move in a number of directions from its initial display position, the control means may make a determination as to the direction in which the chess piece is to move." (Bennett at column 2, lines 10-14; emphasis added.) Bennett provides an example from a preferred embodiment in which "...the controller 44 of the gaming machine 10 selects the direction of movement of the Bishop 50 as it does of the Rook 52. It will be appreciated that the Rook could either move vertically, only along the visible display positions of the fifth reel, or horizontally, in a line across all five reels 18 from its position in the fifth reel. Once again, the controller 44 determines in which direction the Rook will move." (Bennett, column 4, lines 3 to 10; emphasis added.)

Bennett then claims a gaming machine that "...where the chess piece can move in a number of directions from its initial display position, the control means makes a determination as to the direction in which the chess piece is to move." (Bennett, column 5, lines 21 to 24; emphasis added.) Bennett also claims another variety of a gaming machine using a control means in which "the determination [in which direction to execute the movement pattern] is a random determination." (Bennett, column 5, lines 25 to 26.)

Bennett, therefore, requires a control means to determine a direction in which to execute the movement pattern of a playing piece. In the preferred embodiment, Bennett uses the board game of chess in which all playing pieces may execute movement patterns in multiple directions (i.e. with as few as two (2) directions for a Pawn or as many as nine (9) directions for a Queen).

The present invention, however, teaches methods by which wildcard symbols expand in the predetermined directions associated with the symbol without requiring a control means to select one of the directions of expansion. The application includes numerous descriptions and illustrated examples of wildcard symbols expanding without any determination by a control means. (See Directional Wild application, Figures 4a-f, along with accompanying descriptive text on pages 25-31.) To further emphasize the absence of a control means in the present invention, Applicant amends independent Claim 29 at sub-clause (d), and by extension dependent Claims 30 and 31, to include language indicating the automatic nature of the expansion of the wildcard symbol in all directions associated with that wildcard symbol.

3. Bennett teaches a game requiring a control means to determine whether or not to substitute the playing piece for any other symbol.

Bennett's specification states that "...when the chess piece moves from its initial display position to another position in its normal movement pattern, a determination may be made by the control means, when the chess piece is at said other position, as to whether or not a substitution is to be made..." If the determination is that no substitution is to be made, no substitution of the underlying symbol takes place and, if applicable, the chess piece moves to its following position in its movement pattern." (Bennett, column 2, lines 19 to 29; emphasis added.)

Bennett then claims a gaming machine "...in which the control means makes a determination, at each position to which each representation of the playing piece moves, as to whether or not the playing piece is to act as a substitute for the underlying symbol." (Bennett, column 5, lines 11 to 15; also see Bennett at column 6, lines 8 to 13.)

Bennett, therefore, requires a control means to make a substitution determination at each position of movement pattern of a playing piece. In the preferred embodiment, Bennett uses the board game of chess in which playing pieces, such a Knight, may require up to fifteen (15) decisions as is follows its movement patterns.

The present invention, however, teaches methods by which symbols in the path of the expanding wildcard symbol are always replaced by the wildcard symbol without requiring the determination of a control means. The application includes numerous descriptions and illustrated examples of symbols being replaced by wildcard symbols without any determination by a control means. (See Directional Wild application, Figures 4a-f, along with accompanying descriptive text on pages 25-31.) To further emphasize the absence of a control means in the present invention, Applicant amends independent Claim 29 at sub-clause (e), and by extension dependent Claims 30 and 31, to include language indicating the universal replacement of symbols in the path of an expanding wildcard symbol.

4. Bennett teaches a game with a two-stage payment process in which the game pays before and after the movement pattern of a playing piece.

Bennett's specification describes a game wherein "[i]n general, whenever any chess piece substitute symbol is spun up and displayed, then after any applicable wins have been paid, the chess piece will make one move...[and] when it has completed its move, all wins will be paid in which one or more chess pieces substitutes." (Bennett at column 3, lines 40 to 52; emphasis added. Also see Bennett at column 4, lines 13 to 16.)

Further, Bennett's only independent claim states in relevant part that "a wagering game wherein at least one random event is caused to be displayed on the display means and, if a predefined winning event occurs, the machine awards a prize, wherein, when at least one representation of a playing piece of a predetermined board game...is displayed, the at least one representation of the playing piece moves in a pattern corresponding to the predefined movement pattern of that playing piece..." (Bennett, column 4, line 65, to column 5, line 3; emphasis added.)

The Bennett specification, therefore, describes a two-stage payment process in which the game pays for wins, if any, prior to the movement pattern of the playing piece and then pays again for wins created by the movement pattern of the playing pieces. The Bennett claims teach an even more restrictive two-stage payment process which requires a winning event to occur prior to the movement pattern of the playing piece. In either version, Bennett requires a first payment stage prior to the movement pattern of a playing piece and a second payment stage subsequent to the movement pattern of a playing piece.

The present invention, however, teaches a single-stage payment process in which awards, if any, issue after the expansion of wildcard symbols. Specifically, Applicant points to independent Claim 29, and by extension dependent Claims 30 and 31, which teaches a one-time payment method with the issuance of awards as the last step of each game. The language of Claim 29 expands wildcard symbols at sub-clause (d), replaces symbols with the expanded wildcard symbol at sub-clause (e), and then “issu[es] awards for winning symbol combinations following the expansion of all wildcard symbols...” at sub-clause (f).

Conclusion

In view of the foregoing remarks, Applicant respectfully submits that the present invention teaches novel methods of playing a slot machine game using expanding wildcard symbols and that prior art does not show or suggest the novel features recited in Claims 29-31, as currently amended. In particular, Claims 29 to 31 describe the expansion of wildcard symbols in all of the predetermined directions associated with each expanding wildcard symbol, without requiring any control means to determine the direction of expansion and/or the substitution of symbols in the path of said wildcard expansion, using a single-stage payment process that issues awards, if any, following the expansion of all said wildcard symbols.

If there is any matter that would delay this Application from passing to issue, the Examiner is requested to telephone the undersigned.

Applicant strongly emphasizes that anyone reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that

it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable.

Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant is providing examples of why the claims described above are distinguishable over the cited prior art.

Applicant wishes to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicant reserves the right to pursue the original subject matter recited in the present application and claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicant's best attempt at providing one or more definitions of what the Applicant believes to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicant is seeking for this application. Therefore, no estoppel should be presumed, and Applicant's claims are intended to include a scope of protection under the Doctrine of Equivalents.

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For all the reasons advanced above, Applicant respectfully submits that the rejections have been overcome and should be withdrawn. And, for all the reasons advanced above, Applicant respectfully submits that the Application is in condition for allowance, and that such action is earnestly solicited.

Respectfully submitted,

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